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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,835	01/14/2002	Siem-Chun Chou	56868 (71987)	5690
21874	7590	02/24/2004	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/047,835

**Applicant(s)**

CHOU ET AL.

**Examiner**

Taylor Victor Oh

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 7-17 is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/2003 has been entered.

**The Status of Claims:**

Claims 1-17 are pending.

Claim 6 has been rejected.

Claims 1-5 and 7-17 are allowable.

**DETAILED ACTION**

**Priority**

1. It is noted that applicants have satisfied the requirement of 35 USC 119(b) by filing the priority document, Taiwan 090119851, Aug. 14, 2001.

**Drawings**

2. The drawing filed on 01/14/2002 are accepted by the Examiner.

***Specification***

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The disclosure is objected to because of the following informalities: the phrase "are in a ratio of 0-5% " is recited in line 16 on page 9. This expression is unclear; the ratio should be over a specific subject matter: for example, a ratio of nitric acid to the organic phase or a ratio of an oxidant to the organic phase ,or a ratio of the added oxidants to nitric acid. The specification is vague and indefinite as to what ratio is between the specific subject matters.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, the phrase " the oxidant is added in a ratio of 0-5% " is recited . This expression is unclear because the ratio should be over a specific subject matter: for example, a ratio of nitric acid to an organic phase or a ratio of an oxidant to an organic phase ,or a ratio of the added oxidants to nitric acid. Thus, the claim is vague and indefinite as to what ratio is between the specific subject matters. Appropriate correction is required.

***Allowable Subject Matter***

Claims 1-5 and 7-17 are allowable.

The close reference for the current invention is Brunner (U.S. 4,052,441).

Brunner teaches the process of producing esters of monocarboxylic acids and dicarboxylic acids or their esters from the waste solution of cyclohexanone manufacture which consists of salts of monocarboxy and dicarboxy aliphatic acids in the following step of:

- a. acidifying a waste salt solution with a strong acid to produce an aqueous phase and an organic phase;
- b. separating a water-containing fraction from the resulting organic phase by distillation at a temperature below 120<sup>0</sup> C.;
- c. esterifying the aqueous fraction with a lower alcohol in order to produce the desired esters.

The instant invention prior art, however, differ from the prior art in that the claimed waste solution is generated from the caprolactam process instead of the waste solution of cyclohexanone manufacture ; the reaction process is conducted at a temperature of from 120 to 200<sup>0</sup> C ; there are no two-stage concentration steps. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In

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re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached from 8:30-5:00 on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Joseph Mckane*  
2/18/04

*BA K. TRINH*

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PRIMARY EXAMINER  
GROUP 1200

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